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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/672,624	09/26/2003	Richard H. Selinfreund	VTI-107.1B(US)	8082
47670 7590 03/03/2008 KELLEY DRYE & WARREN LLP 400 ATLANTIC STREET, 13TH FLOOR STAMFORD, CT 06901				
EXAMINER				
FRANKLIN, JAMARA ALZAIDA				
ART UNIT		PAPER NUMBER		
2876				
MAIL DATE		DELIVERY MODE		
03/03/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/672,624

Applicant(s)

SELINFREUND ET AL.

Examiner

JAMARA A. FRANKLIN

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 January 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 4-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 4-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/5508)
Paper No(s)/Mail Date 2/14/08
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Acknowledgment is made of the amendment filed on January 09, 2008. Claims 1 and 4-15 are currently pending.

Claim Objections

1. Claims 11-13 are objected to because of the following informalities:
in claim 11, lines 2-3, insert --security-- between “state” and “change”;
in claim 11, line 4, delete “such” and delete “authentic”;
in claim 11, line 5, delete “such”;
in claim 12, line 2, substitute “an” with --the-; and
in claim 13, line 1, substitute “the” with -an--.
Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
3. Claims 1, 4, 11, 12, and therefore dependent claims 5-10 and 13-15, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 1 and 11, the claim language fails to distinctly disclose how the optical data deformation is associated with the transient optical state change material. Is the optical data

deformation located on the item? Is the optical data deformation a physical part of the transient optical state change material?

For examination purposes, the claim will be broadly interpreted to mean that the optical data deformation is somehow a physical part of the transient optical state change material.

Regarding claims 4 and 12, the claim language fails to clearly disclose just how the transient optical state change material is associated with the optical data deformation in a manner to change an optical read of the deformation between at least two optical states when the optical data deformations are read by an optical reader. How can an optical read of one entity (the deformation) be changed because or as a result of the association with another entity (the transient optical state change material)?

Appropriate clarification or correction is required.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 11-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Mennie et al. (US 5,992,601) (hereinafter referred to as 'Mennie').

Mennie teaches

a method for authenticating an item comprising the steps of: (a) detecting an item, a substrate associated with the item, or a transient optical state security change material (security

thread) associated with an optical data deformation (deformation to the substrate as created by security thread), (b) determining the locations of state change materials on the item or substrate associated with the item, and (c) declaring the item as authentic when detection occurs and the transient optical state change material is found at the same locations as an authentic item (col. 45, line 38-46);

the method wherein an optical data change is transient as the transient optical state security change material reverts back from an optical state to an initial optical state within a time interval; and

the method wherein the time interval between optical states may be predetermined.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(e) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 1 and 4-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mennie in view of Baldi (US 6,547,151).

The teachings of Mennie have been discussed above.

Mennie lacks the teaching of an integrated circuit.

Baldi teaches an IC carrier comprising an integrated circuit (col. 2, lines 13-24).

One of ordinary skill in the art would have readily recognized that providing the Mennie invention with an integrated circuit would have been beneficial for providing the document with a manner of storing a large quantity of information within a minimal amount of space. Therefore, it would have been obvious, at the time the invention was made, to modify the teachings of Mennie with the aforementioned teaching of Baldi.

Response to Arguments

9. Applicant's arguments filed January 09, 2007 have been fully considered but they are not persuasive.

In response to the argument that Mennie does not mention anything even remotely related to a method of authenticating an item having a transient optical state change material associated with it, the examiner contends that Mennie does indeed teach a method of authenticating an item having a transient optical state change material as seen in col. 45, lines 30-46 of the Mennie reference.

Furthermore, upon further review and consideration of the claims, a 112, 2nd paragraph rejection has been applied to claims 1, 4, 11, and 12 as these claims do not clearly disclose the

subject matter invention. As a result of the indefinite language, the claims have been interpreted as the examiner deems appropriate as the aforementioned art rejections duly reflect.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMARA A. FRANKLIN whose telephone number is (571)272-2389. The examiner can normally be reached on Monday through Friday 8:00am to 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jamara A. Franklin/
Primary Examiner, Art Unit 2876

JAF
February 21, 2008

